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09/965,003	09/27/2001	Rabindranath Dutta	AUS920010684US1	2730

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EXAMINER

TOMASZEWSKI, MICHAEL

ART UNIT	PAPER NUMBER
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3626

MAIL DATE	DELIVERY MODE
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08/10/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/965,003

Applicant(s)

DUTTA ET AL.

Examiner

Mike Tomaszewski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Notice To Applicant

1. This communication is in response to the amendment filed on 5/29/07. Claims 1-19 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-6 and 8-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Mayaud* (5,845,255; hereinafter *Mayaud*), in view of *Joao* (6,283,761; hereinafter *Joao*), and in view of *Snowden et al.* (US 2002/0026332; hereinafter *Snowden*).

- (A) As per claim 1, *Mayaud* discloses a method comprising:

- (a) receiving a patient prescription for a specified medication (*Mayaud*: col. 27, lines 30-39);

- (b) verifying availability of insurance coverage from an insurance company for the patient prescription (*Mayaud*: col. 15, lines 48-53; col. 21, lines 33-41; col. 53, lines 23-34); and
- (c) verifying an insurance payment category for the prescription (*Mayaud*: col. 5, lines 33-43).

Mayaud, however, fails to expressly disclose a method comprising:

- (d) collecting the payment from the patient based on the payment category;
- (e) transmitting the payment category and the payment to the insurance company; and
- (f) excluding the medication information.

Nevertheless, these features are old and well known, as evidenced by *Joao* and *Snowden*. In particular, *Joao* and *Snowden* disclose a method comprising:

- (d) collecting the payment from the patient based on the payment category (*Joao*: col. 37, lines 47-65);
- (e) transmitting the payment category and the payment to the insurance company (*Joao*: col. 37, lines 47-65; Fig. 1);
- (f) excluding the medication information (*Snowden*: ¶ [0065], [0079], [0085]).

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One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of *Joao* with the combined teachings of *Mayaud* and *Snowden* with the motivation of providing a means for securing the confidentiality of patient information, in whole or in part, while making medical payments (*Joao*: col. 7, lines 16-24).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of *Snowden* with the combined teachings of *Mayaud* and *Joao* with the motivation of providing a means for securing the confidentiality of patient information, in whole or in part, while making medical payments (*Snowden*: ¶ [0121]).

(B) As per claim 2, *Mayaud* discloses the method of claim 1 wherein the payment category is a brand name (*Mayaud*: col. 4, lines 60-65).

Examiner has noted insofar as claim 2 recites, "selected from brand name, generic, and not covered," brand name has been recited.

(C) As per claim 3, *Mayaud* discloses the method of claim 1 further comprising dispensing the prescription to the patient (*Mayaud*: abstract; col. 4, lines 29-35).

(D) As per claim 4, *Mayaud* discloses the method of claim 1 further comprising collecting patient preexisting prescription information and patient insurance information from a storage medium (*Mayaud*: col. 15, lines 47-58; col. 21, lines 33-41; col. 41, lines 42-67; col. 42, lines 1-16; Fig. 12).

(E) As per claim 5, *Mayaud* fails to *expressly* disclose the method of claim 4 further comprising recording the prescription and the payment on the storage medium.

Nevertheless, these features are old and well known, as evidenced by *Joao*. In particular, *Joao* discloses the method of claim 4 further comprising recording the prescription and the payment on the storage medium (*Joao*: col. 16, lines 33-65; col. 17, lines 25-67; col. 18, lines 1-33; col. 19, lines 7-67; col. 20, lines 1-8; col. 37, lines 47-65; Fig. 1).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of *Joao* with the teachings of *Mayaud* with the motivation of providing an apparatus and method for processing and/or providing healthcare information and/or healthcare-related information for facilitating a variety of healthcare applications (*Joao*: col. 8, lines 3-14).

(F) As per claim 6, *Mayaud* discloses the method of claim 1 further comprising checking for adverse reactions between the patient prescription and at least one preexisting patient prescription (*Mayaud*: col. 31, lines 18-67; col. 32, lines 1-21).

(G) Claim 8 differs from method claim 1 by reciting "a computer product in a computer readable medium" within its preamble. As per these elements, *Mayaud's* patient information management system includes computers, databases, interfaces, and gateway-routers, among other components (*Mayaud*: col. 45, lines 7-67; col. 46, lines 1-

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67; col. 47, lines 1-10; Fig. 16). As such, it is readily apparent that *Mayaud's* patient information management system is controlled by a computer product in a computer readable medium."

The remainder of claim 8 substantially repeats the same limitations of method claim 1 and is therefore, rejected for the same reasons given above for claim 1, and incorporated herein.

(HI) Claims 9-13 substantially repeat the same limitations of claims 2-6 and are therefore, rejected for the same reasons given for those claims.

(I) Claim 14 differs from method claim 1 by reciting hardware elements, namely, a receiving means, a first verifying means, a second verifying means, a collecting means, and a transmitting means. As per these elements, it is submitted that because the teachings of *Mayaud* and *Joao* disclose the process steps recited in method claim 1, claim 1, in order to perform the process steps, discloses the aforementioned hardware elements as well. As such, claim 14 substantially repeats the same limitations of method claim 1 and is therefore, rejected for the same reasons given above for claim 1 and incorporated herein.

(J) Claims 15-19 substantially repeat the same limitations of claims 2-6 and are therefore, rejected for the same reasons given for those claims.

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4. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Mayaud*, as applied to claims 1 above, and further in view of *Snowden*.

(A) As per claim 7, *Mayaud* discloses a method comprising:

- (a) storing patient prescription information on a storage medium (*Mayaud*: col. 41, lines 42-67; col. 42, lines 1-16; Fig. 16); and
- (b) providing unlimited access to the prescription information to the patient (*Mayaud*: col. 7, lines 30-45; col. 8, lines 60-63).

Mayaud, however, fails to *expressly* disclose a method comprising:

- (c) providing limited access to the prescription information to third parties in response to authorization by the patient.

Nevertheless, this feature is old and well known in the art, as evidenced by *Snowden*. In particular, *Snowden* discloses a method comprising:

- (c) providing limited access to the prescription information to third parties in response to authorization by the patient (*Snowden*: abstract; ¶ [0079]).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of *Snowden* with the teachings of *Mayaud* with the motivation of providing a means for securing the confidentiality of patient information (*Snowden*: ¶ [0121]).

Response to Arguments

5. Applicant's arguments filed 5/29/07 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 5/29/07.

(A) On page 2 of the 5/29/07 response, Applicant argues that *Snowden* neither suggests nor teaches the withholding of medical information in conjunction with the transmission of a request for payment.

In response, Examiner respectfully submits that the combined teachings of *Mayaud*, *Joao* and *Snowden*, *in toto*, do indeed strongly suggest and teach the withholding of medical information in conjunction with the transmission of a request for payment.

First, *Snowden* teaches that medical information may be made electronically accessible in whole or *select parts* [emphasis added] to appropriate entities (e.g., insurers) (*Snowden*: ¶ [0079]). In other words, certain entities (e.g., insurers) can be

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denied access to certain medical information (e.g., patient's medication information, prescriptions, etc.).

Second, *Mayaud* teaches that access to certain medical information can be restricted to a need-to-know basis (*Mayaud*: col. 10, lines 20-27). *Mayaud* also teaches that medical information can be transmitted between various entities including insurance companies and pharmacies (*Mayaud*: col. 16, lines Fig. 16). In other words, certain medical information (e.g., medication information) can be withheld or provided to various entities (e.g., insurers) as appropriate.

Third, *Joao* teaches a comprehensive medical communication network system whereby various entities can communicate any selected information with one another in a bi-directional manner (*Joao*: col. 37, lines 47-65; Fig. 1). *Joao* also teaches that various entities may perform financial transactions, such as payments, with one another (*Joao*: col. 37, lines 47-65). In other words, a payment from any entity (e.g., provider, patient, etc.) along with any medical information can be transmitted to the insurance company.

As such, Examiner respectfully submits that excluding medication information from a request for payment and any permutations thereof (e.g., excluding diagnosis data from payment requests, excluding examination data from prescription fulfillment requests, excluding prescription history from payment transmissions, *ad infinitum*) is rendered obvious in view of the combined teachings of *Snowden*, *Mayaud* and *Joao*.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Tomaszewski whose telephone number is (571)272-8117. The examiner can normally be reached on M-F 7:00 am - 3:30 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571)272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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